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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,838	07/27/2001	Henry T. Fung	A-67379-1/RMA	9117

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EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/916,838

Applicant(s)

FUNG ET AL.

Examiner

Paul E. Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64 is/are allowed.
- 6) ☒ Claim(s) 42, 45-49, 51, 57-59, 61-63 and 65 is/are rejected.
- 7) ☐ Claim(s) 43, 44, 50, 52-56, 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 42-65 are pending in this application and have been examined. Claims 1-41 having been previously cancelled by preliminary amendment.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 42, 45-49, 51, 57-59, 61-63, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumenthal et al. (US 5,784,460), Takaragi et al. (5,117,458), and Official Notice taken as detailed below.

As per claims 42, 45, 51, 58, 61, 63, and 65, the claimed invention teaches a system where a client computer sends a public PIN, user-specific information, and device specific information to enable a server to appropriately configure content to be downloaded to the client.

The system of Takaragi discloses a system where software is stored at a content server and distributes to remote users (Abstract). Takaragi teaches the further limitations of associating in the server a client identifier, with content attributes appropriate for each said client device having said different client identifier (abstract, fig. 4 item 1203, col. 9 lines 1-21). Takaragi teaches the content server recognizing the hardware and or software characteristics of the client device and customizing the content for compatibility with the client device (Abstract, fig. 4 item 1203).

Blumenthal discloses the limitations not taught by Takaragi, i.e., a remote server that receives a unique password (PIN), user specific information such as software product item numbers, and device specific information such as hardware serial numbers (abstract, col. 4 lines 10-25). The server of Blumenthal uses the received information to generate a decryption key to be downloaded to the client (abstract, col. 4 lines 22-27), the client uses the generated decryption key to decrypt a specified encrypted product (col. 4 lines 27-28). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the features of Blumenthal into the system of Takaragi. It would have been desirable to do so as the use of a client ID containing device specific information and associated in the content server would allow more rapid provision of software content to a client.

As per claims 46 and 57, the combination of Takaragi and Blumenthal does not teach device-specific information that comprises an identifier that is automatically transmitted to said server when the client device is connected (directly) to the network. However Official Notice may be taken of the fact that such a feature is old and well known in the art of network communication protocols. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature into the combination of Takaragi and Blumenthal. It would have been desirable to do so as this would allow for more rapid execution of the communications protocol.

As per claim 47, the combination of Takaragi and Blumenthal does not teach operating systems that are the Microsoft Windows Operating System. However official Notice may be taken of the fact that the use of this operating system in communicating devices as embodied in the claimed invention is a step that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this step into the system of Blumenthal and Takaragi. It would have been desirable to do so as this as it would increase the utility of the system by increasing the number client devices that could be accommodated.

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As per claim 48, Takaragi teaches a content server that provides customized content to the client based upon the device identifier without any prior knowledge of the device configuration in (col. 9 lines 1-21).

As per claims 49 and 62, the combination of Takaragi and Blumenthal does not teach client devices that are cellular telephones or other hand-held devices. However official Notice may be taken that the use of such client devices in a system such as that taught by the combination of Takaragi and Blumenthal is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this step into the system of Takaragi and Blumenthal. It would have been desirable to do so as this would increase the utility and hence marketability of the system.

As per claim 59, The combination of Takaragi and Blumenthal does not teach the content server delivering content comprising books, magazines, movies, video games, (sports), and combinations thereof. However official Notice may be taken of the fact that the delivery of such content by such as that taught by Takaragi and Blumenthal are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature into the system. It would have been desirable to do so as this would increase the marketability and utility of the system.

***Allowable Subject Matter***

4. Claim 64 is allowed.
5. Claims 43, 44, 50, 52-56, and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. The following is a statement of reasons for the indication of allowable subject matter:

As per claim 64, the prior art does not teach dynamic configuration of a mobile ID where a subset of the device ID s dynamically configurable, in combination with the other limitations found in the claim.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336.

The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

3/5/04

*Paul Callahan*